

PATENT COOPERATION TREATY

From the
INTERNATIONAL SEARCHING AUTHORITY

To:

see form PCT/ISA/220

PCT



WRITTEN OPINION OF THE
INTERNATIONAL SEARCHING AUTHORITY
(PCT Rule 43bis.1)

Date of mailing
(day/month/year) see form PCT/ISA/210 (second sheet)

Applicant's or agent's file reference
see form PCT/ISA/220

FOR FURTHER ACTION
See paragraph 2 below

International application No.
PCT/JP2005/010544 ✓

International filing date (day/month/year)
02.06.2005 ✓

Priority date (day/month/year)
03.06.2004 ✓

International Patent Classification (IPC) or both national classification and IPC
H04M1/57, H04M1/2745

Applicant
MATSUSHITA ELECTRIC INDUSTRIAL CO., LTD. ✓

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☒ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☒ Box No. VII Certain defects in the international application
- ☒ Box No. VIII Certain observations on the international application

2. **FURTHER ACTION**

If a demand for international preliminary examination is made, this opinion will usually be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA"). However, this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of three months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

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**WRITTEN OPINION OF THE
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Box No. I Basis of the opinion

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.
 - ☐ This opinion has been established on the basis of a translation from the original language into the following language , which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).
2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:
 - a. type of material:
 - ☐ a sequence listing
 - ☐ table(s) related to the sequence listing
 - b. format of material:
 - ☐ in written format
 - ☐ in computer readable form
 - c. time of filing/furnishing:
 - ☐ contained in the international application as filed.
 - ☐ filed together with the international application in computer readable form.
 - ☐ furnished subsequently to this Authority for the purposes of search.
3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.
4. Additional comments:

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Box No. IV Lack of unity of invention

1. ☒ In response to the invitation (Form PCT/ISA/206) to pay additional fees, the applicant has:
- ☒ paid additional fees.
 - ☐ paid additional fees under protest.
 - ☐ not paid additional fees.
2. ☐ This Authority found that the requirement of unity of invention is not complied with and chose not to invite the applicant to pay additional fees.
3. This Authority considers that the requirement of unity of invention in accordance with Rule 13.1, 13.2 and 13.3 is
- ☐ complied with
 - ☒ not complied with for the following reasons:
see separate sheet
4. Consequently, this report has been established in respect of the following parts of the international application:
- ☒ all parts.
 - ☐ the parts relating to claims Nos.

Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes: Claims	4-9,
	No: Claims	1-3, 10-12
Inventive step (IS)	Yes: Claims	
	No: Claims	1-12
Industrial applicability (IA)	Yes: Claims	1-12
	No: Claims	

2. Citations and explanations

see separate sheet

**WRITTEN OPINION OF THE
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Box No. VII Certain defects in the international application

The following defects in the form or contents of the international application have been noted:

see separate sheet

Box No. VIII Certain observations on the international application

The following observations on the clarity of the claims, description, and drawings or on the question whether the claims are fully supported by the description, are made:

see separate sheet

**WRITTEN OPINION OF THE
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AUTHORITY (SEPARATE SHEET)**

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1. The following documents are referred to in this communication; the numbering will be adhered to in the rest of the procedure:

- D1: ECMA: "Private Telecommunication Networks (PTN) - Signalling Protocol at the S Reference Point - Identification Supplementary Services (SSIG-ID)" STANDARD ECMA-157, [Online] June 1993 (1993-06), XP002341425
Internet Retrieved from the Internet: URL:<http://www.ecma-international.org/publications/files/ECMA-ST/Ecma-157.pdf>> [retrieved on 2005-08-19]
- D2: US 2003/043974 A1 (EMERSON HARRY E) 6 March 2003 (2003-03-06)
- D3: US 2003/120500 A1 (DEEDS DOUGLAS ET AL) 26 June 2003 (2003-06-26)
- D4: SIEMENS: "BEDIENUNGSANLEITUNG SIEMENS S55" SIEMENS S55
USER GUIDE, 2002, page complete, XP002310504

Concerning section IV:

2. Lack of unity of invention

- 2.1 This International Search Authority found multiple (groups of) inventions in this international application, as follows:

Group 1: claims 1-4, 10-12

System and Method for sending personal data together with a presentation attribute from a first telephone to a second one, wherein the display of personal data is dependent on a presentation attribute, and the first, sending phone stores the presentation attribute of the own personal data and displays this presentation attribute together with the personal information of the second phone

Group 2: claims 5-7

A communication terminal which has received personal data together with a presentation attribute and an expiration time from a first phone, wherein the use of the personal data is restricted depending on the expiration time.

Group 3: claims 8-9

The transmission of personal data and of the presentation attribute takes place over a short distance radio communication or over the radio

communication network through which a telephone conversation is carried out.

- 2.2 During the course of the search the following prior art document is considered relevant to assess the unity of the invention.

D1: ECMA: "Private Telecommunication Networks (PTN) - Signalling Protocol at the S Reference Point - Identification Supplementary Services (SSIG-ID)"

- 2.3 All groups of claims have in common a

communication terminal for communicating with another communication terminal via telephone or electronic mail, the communication terminal comprising a communication section operable to receive, from another communication terminal, personal information including at least a telephone number or electronic mail address of the other communication terminal and a presentation attribute that indicates whether presentation of the personal information to a third party is permitted, a personal information storage section operable to store the personal information and presentation attribute acquired from the other communication terminal received by the communication section, a personal information determination section operable to determine whether presentation of the personal information stored in the personal information storage section to the third party is permitted based on the presentation attribute and a personal information presentation section operable to present, to the third party via the communication section, only personal information that has been determined by the personal information determination section to be permitted to be presented to the third party, the personal information having been acquired from the other communication terminal.

Such a system is known from document D1 (see para. 6.5.4.1, para. 8.1, para. 8.3, para 8.5.2. - para. 8.5.5).

- 2.4 The comparison of the 3 groups of inventions with the prior art document D1 result in that the following technical features make a contribution over the state of the art and therefore these technical features can be considered as special technical features within the meaning of Rule 30 EPC:

- i. Claim 3: The sending terminal stores the presentation attribute which has been sent to the second terminal.
- ii. Claim 5: The use of personal data on the receiving side is dependent on an expiration time.
- iii. Claim 8: Personal data and the presentation attribute is over radio communication.

The comparison shows that the special technical features of each group of claims are neither identical nor corresponding as requested by Rule 13.2 PCT.

2.5 The problems solved by these special technical features can be construed as:

- i. Claim 3: to inform the owner of personal data about the status of the data he sent to other terminals.
- ii. Claim 5: to prevent an endless use of personal data on the receiving side.
- iii. Claim 8: to use a wireless connection.

The application therefore addresses 3 different technical problems which are solved by different features.

Therefore the 3 different inventions do not have any special technical features in common nor are they directed towards solving the same technical problem. These inventions are therefore not unitary in the sense of Rule 13.2 PCT.

Concerning section V:

- 3. Reasoned statement with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- 3.1 Document D2 which is considered to represent the most relevant state of the art in the same technical field, discloses in accordance with all features of claim 1 a communication terminal (see fig. 1, Nr. 42, "B") for communicating with another

communication terminal via telephone or electronic mail (see fig. 1, para. 33), the communication terminal comprising:

a communication section (see para. 33) operable to receive, from another communication terminal (see fig. 1, Nr. 42, "B"), personal information including at least a telephone number or electronic mail address of the other communication terminal (see para. 30; para. 40) and

a presentation attribute that indicates whether presentation of the personal information to a third party is permitted (see para. 33);

a personal information storage section (see para. 33; para. 43) operable to store the personal information and presentation attribute acquired from the other communication terminal received by the communication section (see para. 33);

a personal information determination section (see para. 33) operable to determine whether presentation of the personal information stored in the personal information storage section to the third party is permitted based on the presentation attribute (see para. 33) and

a personal information presentation section (see para. 33; para. 42) operable to present, to the third party via the communication section, only personal information that has been determined by the personal information determination section to be permitted to be presented to the third party, the personal information having been acquired from the other communication terminal (see para. 33; para. 42).

As D2 discloses all features of claim 1, the subject-matter of claim 1 is not novel over D2, Article 33(2) PCT.

- 3.2 The independent method claim 10 corresponds to the apparatus claim 1, wherein its features have been reformulated to define method steps. All the features of apparatus claim 1 have already been discussed (see point above). The corresponding method is therefore not novel, Article 33(2) PCT in the light of the disclosure of document D2 (see point above).

- 3.3 Claims 11 and 12 refer to a program and a machine-readable media that provide instructions, which when executed by a communication terminal, cause the communication terminal to perform operations which carries out the method steps of claim 10.

Since the corresponding method is not novel over D2, claims 11 and 12 are also not novel over D2, Article 33(2) PCT.

- 3.4 The additional features introduced by dependent claims 2-9 do not appear to add anything which is both new (Article 33(2) PCT) and of inventive significance (Article 33(3) PCT) to the subject-matter of the claims to which they refer in view of the cited documents as well as the common general knowledge of the skilled person. The reasons for this are as follows:

Claim 2: A personal information determination section allowing a display section included in the communication terminal to display the telephone number or electronic mail address acquired from the other communication terminal, only when the presentation attribute indicates that presentation is permitted is known from document D2 (see para. 33).

Claim 3: A personal information storage section operable to store a presentation attribute of own personal information that has been passed to another communication terminal is known from document D2 (see para. 33). To display the presentation attribute of the own personal information that has been passed to the other communication terminal together with information of the other communication terminal is a minor implementation detail.

Claim 4 differs from the disclosure of document D2 in that the own personal information includes an expiration time of the own personal information, and the communication terminal further comprises a personal information update section which is operable to check whether the expiration time of the own personal information that has been passed to the other communication terminal has expired and is operable to notify a user of the communication terminal that the expiration time of the own personal information that has been passed to the other communication terminal has expired.

The problem to be solved by this additional feature of claim 4 may therefore be regarded as that of how to provide the owner of personal information an

indication, whether his personal information that has been passed to the other communication terminal is still valid.

For a skilled person it is well known that data is valid for a defined period. If the skilled person wants to keep the up-to-dateness of his personal information he would include an expiration time of his data and he would add means to the communication terminal to be notified that the expiration time of the own personal information that has been passed to the other communication terminal has expired.

Therefore the additional feature of claim 4 is not inventive (Article 33(3) PCT).

Claim 5: The subject matter of claim 5 differs from the disclosure of document D2 in that the expiration time is transmitted to the receiving device where the use of this data is restricted the time of use has expired.

The problem to be solved by this additional features is to be understood as how to prevent an endless use of personal data on the receiving side.

The solution proposed in claim 5 of the present application cannot be considered as involving an inventive step (Articles 33(3) PCT) for the following reason:

The feature of an expiration time included in data which has been transmitted to a receiving terminal is a common known technique (see document D3, para. 33). The skilled person would therefore regard it as a normal design option to include this feature in the system described in document D2 in order to solve the problem posed.

Claim 6: Means for notifying the user of the receiving device of the expiration time and the restrictions is known from document D3 (see para 33). Obviously the user is informed about the restrictions of use in that the user cannot access the personal data any more.

Claim 7: To delete the personal data when the time of use has expired is a logical consequence as this data has no further use any more. Therefore to implement means to delete the personal data when the time of use has expired is not inventive (Article 33(3) PCT).

Claims 8 and 9: A communication section for transmitting or receiving personal information by utilizing short distance radio communication or a radio

communication network through which a telephone conversation is carried out or an electronic mail is transmitted or received is a standard feature of common mobile phones and are well known (see document D4, page 15). For a skilled person it would be obvious to reuse the same transmission path to transmit also the presentation attribute. Hence the additional features of claims 8 and 9 are not inventive (Article 33(3) PCT).

In summary, the dependent claims 2-9 do not appear to add any additional features to the subject-matter of the claims to which they refer, which are both new (Article 33(2) PCT) and of inventive significance (Article 33(3) PCT).

Concerning section VII:

1. The independent claims should have been drafted in the proper two-part "characterised" form recommended by Rule 6.3.(b),(I),(ii) PCT, having a preamble that correctly reflects the nearest prior art, presumably that represented by the above noted document D1 and D2.
2. In order to meet the requirements of Rule 5.1.(a),(ii) PCT, the relevant prior art, i.e. the document noted above, should have been acknowledged by reference and briefly discussed in the introductory part of the description.
3. All the claims should have included reference signs in parentheses where features shown in the drawings are referred to, Rule 6.2.(b) PCT.

Concerning section VIII:

1. Claim 1 lacks clarity (Article 6 PCT) due to the fact that the matter for which protection is sought is not clearly defined. The apparatus claim is defined by method-steps:

"A communication terminal [...] the communication terminal comprising: [...] a presentation attribute that indicates whether presentation of the personal information to a third party is permitted; [...]"

The features in the apparatus claim relate to a method of using the apparatus rather than clearly defining the apparatus in terms of its technical features. The

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intended limitations are therefore not clear from this claim, contrary to the requirements of Article 6 PCT.

This problem could have been overcome by defining additional technical means which are adapted to execute the actions.

This problem relates also to apparatus claims 2.